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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,640	01/16/2001	G. Colby Conkwright	37865.010200	2254

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GREENBERG-TRAURIG  
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MCLEAN, VA 22102

EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 08/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/759,640

Applicant(s)

CONKWRIGHT ET AL.

Examiner

Ella Colbert

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-80 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-19, drawn to a system for taking a survey, classified in class 705, subclass 14.
  - II. Claims 20-29 and 67-79, drawn to a method for correlating dynamic and static datasets, classified in class 725, subclass 14.
  - III. Claims 30, 31, 63, and 64, drawn to a method for monitoring set-top box operations, classified in class 725, subclass 9.
  - IV. Claims 36-39, drawn to a method for determining effect of content attributes on content ratings, classified in class 725, subclass 35.
  - V. Claim 80, drawn to a method for invalidation of set-top box events, classified in class 725, subclass 2.
2. The inventions are distinct, each from the other because of the following reasons:

Groups I-V are related as subcombination and species disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. The subcombinations are distinct from each other if they are shown to be separately usable. These combinations are independent if it can be shown that (1) they are not disclosed as capable of use together, (2) they have different modes of operation, (3) they have different functions, or (4) they have different effects. (MPEP 806.04, MPEP 808.01). In the instant case, Group I has separate utility such as system steps for collecting (acquiring) marketing data that are not required of

Art Unit: 3624

the independent claims of Groups II, III, IV, and V. Group II recites limitations in its independent claims requiring method steps for correlating dynamic and static datasets that are not required of independent claims of Groups I, III, IV, and V. Group III recites limitations of method steps for monitoring set-top box operations (events) that are not required for Groups I, II, IV, and V. Group IV recites limitations of method steps of determining the effect of content attribute ratings by obtaining content attributes, recording set-top box events, correlating set-top box events, and analyzing correlations over time that are not required for Groups I, II, III, and V. Group V recites limitations of method steps for invalidating set-top box events that are not required for Groups I, II, III, and IV.

The independent claims in each Group I-V recite limitations that are not found together in a common independent claim of another Group, thus it is evidence that Applicants' believe a distinct invention combination lies within each set of independent claims. Also, the dependent claims the append a multiple of distinct inventive concepts for which Applicants' submission is evidence that Applicants' believe each supports a distinct reason for invention. See MPEP § 806.05(d).

4. Applicants' are requested to elect and define support in the figures of one of the Groups I-V to be examined. Note that these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognizwd divergent subject matter, restriction is appropriate.

Art Unit: 3624

5. A telephone call was made to Mr. James E. Goepel and Mr. Richard Kurtz on August 15, 2002, to request an oral election to the above restriction requirement, but did not result in an election being made.

6. Applicants' are advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed, Applicants' are respectfully required to cancel the non-elected claims in response to this requirement.

7. Applicants' are reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. §1.48(b) and by the fee required under 37 C.F.R. §1.17(h).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for Official communications and 703-746-5622 for Non Official communications.

Application/Control Number: 09/759,640

Page 5

Art Unit: 3624

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

A handwritten signature in black ink, appearing to read "E. Colbert", with a long horizontal flourish extending to the right.

E. Colbert  
August 21, 2002